

10/07/03 41

1712



750 BERING DRIVE
HOUSTON, TX 77057-2198
PHONE 713.787.1400
FAX 713.787.1440
A LIMITED LIABILITY PARTNERSHIP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
OCT 14 2003
TC 1700

In re Application of:
Arvind D. Patel et al.

Group Art Unit: 1712

Serial No.: 09/927,619

Examiner: Tucker, Philip

Confirmation No.: 5353

Atty. Dkt. No.: 11836.0702.NPUS00
MIDR:702

Filed: August 10, 2001

For: BIODEGRADABLE SURFACTANT FOR INVERT
EMULSION DRILLING FLUID

RESPONSE TO NON-FINAL OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

| | |
|--|---------------------------------|
| EXPRESS MAIL MAILING LABEL | |
| EV348202331US | |
| NUMBER | DATE OF DEPOSIT October 6, 2003 |
| I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. | |
| <i>Barbi Sofia</i> | |
| Signature | |

INTRODUCTORY COMMENTS:

The following is in response to the Office Action dated June 4, 2003.

☒ The Commissioner is hereby authorized to deduct the one-month extension of time fee and any other necessary fees regarding this application from Deposit Account No. 01-2508, Order No. 11836.0689.PCUS00.

IN RESPONSE TO THE OFFICE ACTION:

FIRST REJECTION UNDER 35 U.S.C. § 103:

Claims 1, 4-9, 11, 13, 14, 17-22, 25-30, 32 and 35 have been rejected under 35 U.S.C. §103(a) as being unpatentable given the published international application WO 96/18383 (the WO '383 reference) in view of U.S. Patent No. 2,900,336 issued to Brown (the Brown reference) and U.S. Patent No. 5,189,012 issued to Patel (the Patel reference).

Applicants request that the Examiner reconsider and withdraw the above rejection of the claims after consideration of the following.

A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ 2d 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior

art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner bears the burden of establishing a *prima facie* case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a *prima facie* case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *In re Deuel*, 51 F.3d 1552, 1553, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Applicant submits that nothing in the art of record teaches or suggests the subject matter recited in independent claim 1 and thus a *prima facie* case obviousness has not been established. Applicant submits that nothing in the art of record teaches or suggests the present invention.

The subject matter generally disclosed in the WO'383 reference is directed to emulsions that contain a combination of emulsifiers having specific HLB values and an emulsion stabilizer (i.e. magnesium sulfate). One of skill in the art would immediately understand and appreciate that the disclosed emulsions are cream-like and paste-like in nature. As specifically indicated in WO'383, the intention is to formulate emulsions that can be subjected to multiple freeze thaw cycles and not exhibit phase separation. As is shown on page 9 of the WO '383 reference, variations in the formulation of the disclosed formulations result in unstable invert emulsions which in accordance with the teaching of the disclosure are thus undesirable. This shows to one of skill in the art that adjustment of the formulation to one outside the disclosure of the WO '383 teachings of a combination of emulsifiers and an emulsion stabilizer result in undesirable emulsions. Finally it should be noted that the WO '383 reference is directed to formulation of cosmetic creams and lotions, not drilling fluids and one of skill in the art of drilling fluids would not turn to the hand lotion arts in search of its teachings regarding the formulation of invert emulsions.

Thus Applicant submits that nothing in the art of record teaches to suggest the formulation of a drilling fluid as recited in independent claims 1, 9, 11 and 13.

As noted above, the emulsions of the WO '383 reference are cosmic creams and lotions. Nothing in the art of record teaches or suggests the inclusion of a weighting agent into the formulation of a cosmetic cream or lotion would yield a drilling fluid as is recited in the claims. Further, Applicant asserts that nothing in the art of record provides the necessary expectation of success that is needed to establish a prima facie case of obviousness under 35 U.S. C. §103(a). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992). Applicant submits that it is only with hind sight and the benefit of the present disclosure does one see the desire to make the modifications necessary to achieve such a result.

Further it should be noted that nothing in the art of record teaches the use of the fluids as is positively claimed in independent claims 1, 22, 32 and 35. That is to say one of skill in the art would not make the modifications necessary to make or use a cosmetic cream or lotion useful as a drilling fluid as is positively recited in the claims.

Given the above, Applicant requests that the rejection of claims 1, 4-9, 11, 13, 14, 17-22, 25-30, 32 and 35 under 35 U.S.C. §103(a) be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11836.0702.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.



Serial No.: 09/927,619

Confirmation No.: 5353

Applicant: PATEL, Arvind D. et al.

Atty. Ref.: 11836.0702.NPUS00

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Carter J. White".

Carter J. White

Patent Attorney

Reg. No. 41374

Tel. 713 268 1372

Date: 16 Oct 03